

### REMARKS

The Official Action dated January 20, 2004, has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 13-17 and 21-23 have been cancelled and claim 7 has been amended. Support for the amendment to claim 7 may be found at page 2, lines 6-9. Since these changes do not involve any introduction of new matter, entry is believed to be in order and is respectfully requested.

In the Official Action, claims 1-2, 6-17 and 21-23 were rejected under 35 U.S.C. §102(e) as being anticipated by Ito et al. (U.S. Patent No. 6,529,522). The Examiner asserted that Ito et al. teach a photoprinter configuration comprising: a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via communication link, the photoprinter being operative to control the viewable display of the digital camera, and wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium. However, as will be set forth in detail below, it is submitted that the photoprinter configurations and methods for controlling a digital camera defined by claims 1-2 and 6-12 are not anticipated by Ito et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed to a photoprinter configuration. The configuration comprises: a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being **operative to control the viewable display** of the

digital camera, and wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium.

As defined by claim 7, the present invention is directed toward a method for controlling a digital camera. The method comprises the steps of: obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operable to print digital photographs onto printable media, wherein processing the digital files comprises calculating a pixel pattern to be printed on the printable media; obtaining a digital camera comprising a viewable display and one or more selection mechanisms; connecting the digital camera to the photoprinter via a communication link; transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and controlling the digital camera by the photoprinter in accordance with the plurality of instructions, wherein at least a portion of the instructions are **operative to control the viewable display** of the digital camera.

Ito et al. disclose a communication apparatus comprising a first communication interface for executing communication based on a first communication method and a second communication interface for executing communication based on a second communication method. Ito et al. further disclose a digital camera and a printing apparatus in communication with each other through either the first or second communication interface. While Ito et al. disclose a printer or other device can control the digital camera, Applicants find no teaching or disclosure by Ito et al. of a photoprinter configuration comprising a photoprinter capable of **controlling the viewable display** of the digital camera.

Apparently, the Examiner is relying on Ito et al. disclosing that the digital camera can be controlled from any device (see column 17, lines 44-46) for teaching the limitation that the photoprinter is operative to control a viewable display of the camera (claim 1) and the limitation that the digital camera is controlled by the photoprinter in accordance

with a plurality of instructions transmitted from the photoprinter, wherein at least a portion of the instructions are operative to control the viewable display of the digital camera (claim 7). However, when Ito et al. discuss controlling the digital camera from the printer or other device, it appears to do so exclusively in the context of transferring image data to and/or from the digital camera to the other device. There is no teaching, disclosure or suggestion of being able to control the viewable display of the digital camera. As such, it does not disclose or teach a photoprinter operative to control a viewable display of the camera (claim 1) or controlling a digital camera in accordance with a plurality of instructions transmitted from the photoprinter, wherein at least a portion of the instructions are operative to control the viewable display of the digital camera (claim 7).

Anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claims under consideration, *Alco Standard Corp. v. TVA*, 808 F.2d 1490, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). As Applicants find no teaching by Ito et al. relating to a photoprinter, capable of processing digital files independent of an external host device, operative to control a viewable display of a camera (claim 1) or controlling a digital camera by a photoprinter, capable of processing digital files independent of an external host device, in accordance with a plurality of instructions transmitted from the photoprinter, wherein at least a portion of the instructions are operative to control the viewable display of the digital camera (claim 7), Ito et al. fail to anticipate claims 1 and 7, or any of the claims that depend therefrom (e.g., claims 2 and 6, and 8-12, respectively) under 35 U.S.C. §102.


The Examiner has asserted that the presently claimed invention inherently reads on Ito et al. To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. However, such evidence must make clear that the missing descriptive matter is **necessarily**

present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981). Moreover, "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich, supra*. Applicants assert that the photoprinter being operative to control the viewable display of the digital camera is not necessarily present in the photoprinter disclosed in Ito et al. It is therefore submitted that the presently claimed printer configurations and methods are not anticipated by Ito et al., whereby the rejection under 35 U.S.C. §102(e) has been overcome. Reconsideration is respectfully requested.

Finally, Applicants appreciate the Examiner's indication of the allowable subject matter of claims 24-26.

It is believed that the above represents a complete response to the Examiner's rejection under 35 U.S.C. §102 and places the present the application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,



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